

RECEIVED
CENTRAL FAX CENTER

MAY 31 2006

VENABLE LLP
ATTORNEYS AT LAW

575 7th Street, NW
Washington, D.C. 20004-1601
(202) 344-4000, Fax (202) 344-8300

WASHINGTON, DC · MARYLAND · VIRGINIA · NEW YORK

FAX COVER SHEET

DATE:	May 26, 2006
TO FAX NO:	(571) 273-0830
DELIVER TO:	Examiner Minh-Tam DAVIS
FIRM NAME:	United States Patent and Trademark Office – Group 1642
FROM:	Nancy J. Axelrod, Ph.D. (202) 344-8334 njaxelrod@venable.com
TOTAL NO. OF PAGES (INCLUDING THIS PAGE):	7
RE:	U.S. Patent Application No. 09/743,825 – CHAQUI <i>et al.</i>
OUR REFERENCE NO.:	31978-202420

CONFIDENTIALITY NOTICE

WARNING:

Unauthorized interception of this telephonic communication could be a violation of Federal and State Law

The documents accompanying this telecopy transmission contain confidential information belonging to the sender which is legally privileged. The information is intended only for the use of the individual or entity named above. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution or the taking of any action in reliance on the contents of this telecopied information is strictly prohibited. If you have received this telecopy in error, please immediately notify us by telephone to arrange for return of the original documents to us.

755225

RECEIVED
CENTRAL FAX CENTER

MAY 31 2006

133135

Venable Filing Number

Attorney/LAA: NJA/SJB
PTO Due Date: N/A
Date Filed: MAY 26, 2006
TM Official Gazette Date:

Atty. Docket No: 31978-202420
Re: "PB39, A GENE DYSREGULATED IN PROSTATE
CANCER, AND USES THEREOF" -
Rodrigo F. CHAQUI et al.
Application No: 09/743,825
Patent No.:

App'n Filing Date: JANUARY 15, 2002
Issue Date:

The following items were received from Venable, Washington, D.C., by the U.S. Patent & Trademark Office:

U.S. PTO FEES ENCLOSED

- ☒ TRANSMITTAL FORM
☒ FEE TRANSMITTAL LETTER
☐ New U.S. Utility Application (pages of specification/claims)
☐ Submission Of Formal Drawings (Sheets, Figs.)
☐ Invention Declaration
☐ U.S. National Stage Application of PCT Application
☐ Translation of International Application
☐ New U.S. TM Application (specimens)
☐ Rule 53(d) Continued Prosecution Application
☐ Substitute Specification
☐ Rule 53(b) Continuation or Divisional Application (attach copy of specification,
claims, drawings & declaration)
☐ Priority Document-Cert. Copy of Appln.#: ; Country
☐ Date Filed:
☐ Request for Continued Examination (RCE) under 37 CFR 1.114
☐ Request for Reconsideration
☐ Application Data Sheet
☐ Assignment w/Cover Sheet
☐ IDS w/ PTO SB/08A
☐ Amendment
**SUBMISSION OF ASSIGNEE CONSENT TO CORRECT
INVENTORSHIP; ASSIGNEE CONSENT UNDER 37 C.F.R.
§ 1.48(d)**
☒ Petition For Extension Of Time
☐ Notice of Appeal
☐ Appeal Brief (in triplicate)
☐ Reply Brief (in triplicate)/ Request for Oral Hearing
☐ Confirmation of Hearing Petition
☐ Issue & Publication Fees Transmittal
☐ Certificate of Correction
☐ Maintenance Fee Transmittal
☐ Power of Attorney
☐ Response to Notice to File Missing Parts
☐ Response to Notice to File Missing Requirements
☐ Response to Restriction Requirement
☐ Petition to Revoke
☐ Sequence Listing - CDR Enclosed? ☐ Yes ☐ No
☐ Status Inquiry
☐ Request for Non-Publication
☐ Request to Rescind Non-Publication Request
☐ Terminal Disclaimer
☐ Notice of Opposition (Please list all documents in Other section)
☐ Amendment to Alleged Use

Filing Fee
Surcharge Fee
Additional Claim Fee
Recordation/Indexing Fee
IDS Fee
Extension Fee
Notice of Appeal Fee
Brief on Appeal Fee
Oral Hearing Request Fee
Petition Fee
Issue Fee
Publication Fee
Maintenance Fee
TM Statement of Use
8 Affidavit Fee
8 and 15 Affidavit
TM Renewal Application Fee
Notice of Opposition Fee
TM Extension of Time Fee
-NONE- Total Fees Paid

☐ Check Number Attached
☒ Charge Deposit Account No. 22-0261 If
there is any fee.

#755198

**RECEIVED
CENTRAL FAX CENTER**

MAY 31 2006

PTO/SB/21 (08-00)

Please type a plus sign (+) inside this box → ☒

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1996, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/743,825	
	Filing Date	January 15, 2002	
	First Named Inventor	Rodrigo F. CHAQUI	
	Group Art Unit	1842	
	Examiner Name	Minh-Tam DAVIS	
Total Number of Pages In This Submission	5	Attorney Docket Number	31978-202420

ENCLOSURES (check all that apply)				
<input checked="" type="checkbox"/> Fee Transmittal Form (No Fee) <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts Under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input checked="" type="checkbox"/> Submission of Assignee Consent to Correct Inventorship; Assignee Consent Under 37 C.F.R. § 1.48(d) <input type="checkbox"/> Other Enclosure(s) (please identify below):		
<table border="1"> <tr> <td>Remarks</td> <td></td> </tr> </table>			Remarks	
Remarks				

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual name	Nancy J. Axelrod, Ph.D. Patent Agent Reg. No. 44,014	26694 <small>ATTENT TRADEMARK OFFICE</small>
Signature	<i>Nancy Axelrod</i>	
Date	May 26, 2006	

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on this date: _____			
Typed or printed name			
Signature		Date	

VENABLE
ATTORNEYS AT LAW

SEND TO: Commissioner for Patents, P. O. Box 1450, Alexandria, 22313-1450.
#755203

RECEIVED
CENTRAL FAX CENTER

MAY 31 2006

PTO/SB/17 (12-04v2)

Approved for use through 7/31/2006. OMB 0851-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

<p>Effective on 12/09/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4616).</p> <p>FEE TRANSMITTAL For FY 2006</p>		<p>Complete if Known</p>	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Application Number	09/743,825
TOTAL AMOUNT OF PAYMENT (\$)		Filing Date	January 15, 2002
		First Named Inventor	Rodrigo F. CHAQUI
		Examiner Name	Minh-Tam DAVIS
		Art Unit	1642
		Attorney Docket No.	31978-202420

<p>METHOD OF PAYMENT (check all that apply)</p>	
<input type="checkbox"/> Check <input type="checkbox"/> Credit Card <input type="checkbox"/> Money Order <input type="checkbox"/> None <input type="checkbox"/> Other (please specify) _____	
<input checked="" type="checkbox"/> Deposit Account Deposit Account Number: <u>22-0261</u> Deposit Account Name: <u>Venable LLP</u>	
<p>For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)</p>	
<input checked="" type="checkbox"/> Charge fee(s) indicated below <input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee	
<input checked="" type="checkbox"/> Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17 <input checked="" type="checkbox"/> Credit any overpayments	

<p>FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)</p>							
<p>1. BASIC FILING, SEARCH, AND EXAMINATION FEES</p>							
	FILING FEES		SEARCH FEES		EXAMINATION FEES		
		Small Entity		Small Entity		Small Entity	
Application Type	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fees Paid (\$)
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	
<p>2. EXCESS CLAIM FEES</p>							
						Small Entity	
						Fee (\$)	Fee (\$)
Each claim over 20 (including Reissues)						50	25
Each independent claim over 3 (including Reissues)						200	100
Multiple dependent claims						360	180
Total Claims		Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims		
- 20 =		x	=		Fee (\$)		Fee Paid (\$)
<p>HP = highest number of total claims paid for, if greater than 20.</p>							
Indep. Claims		Extra Claims	Fee (\$)	Fee Paid (\$)			
- 3 =		x	=				
<p>HP = highest number of total claims paid for, if greater than 3.</p>							
<p>3. APPLICATION SIZE FEE</p>							
<p>If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).</p>							
Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof		Fee (\$)	Fee Paid (\$)		
- 100 =	/50	(round up to a whole number) x		=	Fees Paid (\$)		
<p>4. OTHER FEE(S)</p>							
<p>Non-English Specification, \$130 fee (no small entity discount)</p>							
<p>Other (e.g., late filing surcharge):</p>							

<p>SUBMITTED BY</p>			
Signature	<u>Nancy J. Axelrod</u>	Registration No. (Attorney/Agent)	44,014
Name (Print/Type)	Nancy J. Axelrod, Ph.D. - Patent Agent	Telephone	(202) 344-4000
		Date	May 26, 2006

#755200

RECEIVED
CENTRAL FAX CENTER

MAY 31 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Rodrigo F. CHAQUI *et al.*

Application No.: 09/743,825

Filed: January 15, 2002

For: PB39, A GENE DYSREGULATED IN
PROSTATE CANCER, AND USES
THEREOF

Confirmation No.: 8611

Art Unit: 1642

Examiner: Minh-Tam DAVIS

Atty. Docket No. 31978-202420

Customer No.:
26694
PATENT TRADEMARK OFFICE

SUBMISSION OF ASSIGNEE CONSENT TO CORRECT INVENTORSHIP

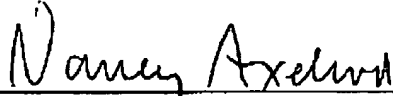
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to counsel's recent telephone conversations with Examiner Davis, Applicants herewith submit an Assignee Consent Under 37 C.F.R. § 1.48(d) to the Request to Correct Inventorship (adding Michael R. Emmert-Buck as an inventor) that was filed with the Patent and Trademark Office on November 9, 2004.

Respectfully submitted,

Date: May 26, 2006



Nancy J. Axelrod, Ph.D.
Patent Agent
Registration No. 44,014
VENABLE, LLP
Post Office Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 344-4000
Telefax : (202) 344-8300

NJA/SJB
#755193

RECEIVED
CENTRAL FAX CENTER

MAY 31 2006

Docket No.: 31978-202420
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Chuaqui et al.

Application No.: 09/743825

Confirmation No.: 8611

Filed: January 15, 2002

Art Unit: 1642

For: PB39, A GENE DYSREGULATED IN
PROSTATE CANCER, AND USES
THEREOF

Examiner: M. T. B. Davis

USPTO Customer No.: 45323

ASSIGNEE CONSENT UNDER 37 C.F.R. § 1.48(d)

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Government of the United States of America, as represented by the Secretary, Health and Human Services, National Institutes of Health, Office of Technology Transfer, 6011 Executive Boulevard, Suite 325, Rockville, MD 20852-3804, is the assignee of this application. The original inventors executed an Assignment on 01/12/2004, 02/03/2004 and 01/13/2004. The executed Assignment was submitted with a Recordation Form coversheet on 02/03/2004. The


Application No.: 09/743825

Docket No.: 31978-202420

undersigned hereby consents to the Request to Correct Inventorship, which was submitted on 11/09/2004, adding Michael R. Emmert-Buck as an additional inventor.

Respectfully submitted

Date: May 25, 2006

 Reg. No. 46,629

The Government of the United States of America, as
represented by the Secretary, Health and Human
Services

National Institutes of Health
Office of Technology Transfer
6011 Executive Boulevard, Suite 325
Rockville, MD 20852-3804

752399